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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,763	03/16/2004	Michael Berkei	17541	3419
23389	7590	06/20/2006	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			FAISON GEE, VERONICA FAYE	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/801,763

Applicant(s)

BERKEI ET AL.

Examiner

Veronica Faison-Gee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 19-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Claims 5, 6, 9, 11-13 have been amended, claims 19-21 have been added and claims 15-18 have been canceled. Hence, claims 1-14 and 19-21 are pending in the application.

Applicant's arguments are persuasive to the extent that the rejections previous Office Action has been withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over English Translation of WO 02/41826.

WO 02/41826 teaches transferring inorganic colloids, in particular nanoparticles, from an organic starting solution into a solution, where the target solution is either an inorganic, in particular aqueous solution. The reference teaches that the inorganic colloids have diameters in the range of 0.1 to 1000 nm. The reference further teaches that 4-dimethylaminopyridine (DMAP) and mecrocaptoundecanoic acid may be present in the process. Gold is a particular nanoparticle which the reference places a DMAP shell. The reference also discloses that the particle size is the in range of that taught by

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Applicant. See page 4, lines 4-22, page 5 line 22-page 6 line 3, page 6 line 25-page 7 line 17, page 11 lines 5-14, page 14 line 9+ and page 21 line 4+.

WO 02/41826 fails to specifically exemplify the use of 4-dimethylaminopyridine (DMAP) and mecrocaptoundecanoic acid as claimed by applicant. Therefore, it would have been obvious to one of ordinary skill in the art to use the specific 4-dimethylaminopyridine (DMAP) and mecrocaptoundecanoic acid as claimed by applicant as WO 02/41826 also discloses the use of 4-dimethylaminopyridine (DMAP) and mecrocaptoundecanoic acid but shows no example incorporating them.

Claims 1-14 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki et al (US Patent 5,743,946) in view WO 02/41826.

Aoki et al teach a water-color ink composition comprising a fusible inorganic component, an aqueous medium and an organic binder (abstract and col. 2 lines 43-50). The aqueous medium is a combination of water and an organic solvent such as ethylene glycol (col. 2 lines 51-67) wherein the solvent may be present in the amount of 5 to 95 percent by weight in the aqueous medium (col. 3 lines 1-2). The reference also teaches that the fusible inorganic component may be a powder, a micropowder or a colloidal dispersion of a metal such as gold (col. 6 lines 1-19). Conventional additives such as dispersant, wetting agent, and defoaming agent may also be present in the ink composition (col. 7 lines 18-23).

When general conditions (mixing amounts) are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by changing the size, shape, proportion of shape, degree and sequence of added ingredients through routine

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experimentation. (In re Rose, 105 USPQ 137; In re Aller 220F, 2d 454, 105 USPQ 233,235 (CCPA 1955); In re Dailey et al., 149 USPQ 47; In re Reese, 129 USPQ 402; In re Gibson, 45 USPQ 230). It is well known in the art that inks may be used in various printing method and that it is obvious to vary the components for the particular printing method.

WO 02/41826 is described above.

Therefore it would have been obvious to one of ordinary skill in the art to use the gold colloidal taught by WO 02/41826 in the ink composition of Aoki et al because Aoki et al broadly teaches a metal colloidal that may be present in the ink composition

Response to Arguments

Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Veronica Faison-Gee whose telephone number is 571-272-1366. The examiner can normally be reached on Monday-Thursday and alternate Fridays 8 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

vfg
6-12-06


J.A. LORENZO
SUPERVISORY PATENT EXAMINER